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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of Dale Burns

Serial No.: 09/182,033

Group Art Unit: 2164

Filed: 10/29/98

Examiner: Kazimi, H.

For: **ELECTRONIC COUPON PROCESSING SYSTEM**

Mail Stop Appeal Brief - Patent  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**RECEIVED**

APR 05 2004

**GROUP 3600**

Dear Sir:

Enclosed please find the following:

1. Request for Reinstatement of Appeal;
2. Supplemental Brief on Appeal (one original and two copies).

The Commissioner is hereby authorized to charge any fee deficiency, or credit any overpayment, to Deposit Account No. 18-1579. The Commissioner is also authorized to charge Deposit Account No. 18-1579 for any future fees connected in any way to this application. Two copies of this letter are enclosed.

Respectfully submitted,

Christopher B Kilner  
Registration No. 45,381  
Roberts Abokhair & Mardula, LLC  
11800 Sunrise Valley Drive, Suite 1000  
Reston, VA 20191  
(703) 391-2900

Date: March 29, 2004

Atty. Dkt. No.: 2391-001



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**Appellant's Request for Reinstatement of Appeal Under 37 C.F.R. §1.193(b)(2)(ii)**  
\*\*\*\*\*

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Dear Sir:

In accordance with the provisions of 37 C.F.R. §1.193(b)(2)(ii), Appellant exercises the option of requesting that the Appeal be reinstated without undue delay. As required by 37 C.F.R. §1.193(b)(2)(ii), Appellant submits a Supplemental Appeal Brief (original and two copies) herewith.

The Commissioner is hereby authorized to charge Deposit Account No. 18-1579 for any fee deemed necessary for consideration of the Supplemental Appeal Brief. A duplicate copy of this paper is attached.

Respectfully submitted,

Christopher B Kilner  
Registration No. 45,381  
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**Appellant's Supplemental Brief On Appeal Under 37 C.F.R. § 1.193(b)(2)(ii)**  
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Dear Sir:

In reply to the Office Action mailed January 27, 2004 and in accordance with the provisions of 37 C.F.R. § 1.193(b)(2)(ii), Appellant requests that the Appeal be reinstated and submits the following:

Appellant hereby affirms that items I-II and VII of the Brief on Appeal filed September 10, 2001 remain the same. It is Appellant's understanding that there is no need to reiterate contentions and information which were set forth in the Brief on Appeal. See 62 Fed. Reg. 53,132, 53,169 (1997) ("Contentions (or information) set forth in a previously filed appeal (or reply brief) need not be reiterated in a reply brief or supplemental appeal brief.").

**III. STATUS OF CLAIMS**

Claims 30-49 are currently pending. The Board of Patent Appeals and Interferences

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previously affirmed the Examiner's rejections of claims 30-37, 39-47, and 49. The Board of Patent Appeals and Interferences previously reversed the Examiner's rejections with respect to claims 38 and 48. No claims have been allowed. Claims 1-29 have been canceled. Claims 30-49 are appealed. Claims 30-49, as finally rejected, are set forth in the attached Appendix.

#### **IV. STATUS OF AMENDMENTS**

Claims 30 and 40 were amended in the Amendment of November 6, 2003 and/or Supplement Amendment of November 14, 2003. These amendments were proper and entered since the Patent Office had reopened prosecution.

#### **V. SUMMARY OF THE INVENTION**

The present invention is substantially the same as submitted in the Appeal Brief filed September 10, 2001, but requires some clarification due to the Amendments of claims 30 and 40.

With respect to the system discussed over pages 7, 8, and 9 of the Appeal Brief filed September 10, 2001, the system (claim 30) further includes the limitation of the system including means to add unutilized coupon information directly to consumer accounts (see page 8, lines 17-20 of the specification). The ability for the system to add unutilized coupon information directly to consumer accounts both allows for targeted coupon distribution, such as the later claimed (claim 32) addition of coupons based upon collected market information for the consumer, and prevents possible fraudulent selection of electronic coupons as is possible with prior art systems such as Nichtberger et al.

Likewise, with respect to the process discussed over pages 10 and 11 of the Appeal Brief filed September 10, 2001, the process (claim 40) has been clarified to identify which steps are performed by the system further includes the limitation that the system can add unutilized coupon information directly to consumer accounts (see page 8, lines 17-20 of the specification). In the same manner as above, the ability for the system to add unutilized coupon information directly to consumer accounts both allows for targeted coupon distribution, such as the later claimed (claim 42) addition of coupons based upon collected market information for the consumer, and prevents possible fraudulent selection of electronic coupons as is possible with prior art systems such as Nichtberger et al.

## VI. ISSUES

The issues on Appeal remain the same as when the Appeal Brief was filed September 10, 2001:

Are claims 30-37, 39-47, and 49 obvious over U.S. Patent No. 4,882,675 to Nichtberger et al. in view of U.S. Patent No. 5,822,735 to DeLapa et al.?

Are claims 38 and 48 obvious over U.S. Patent No. 4,882,675 to Nichtberger et al. in view of U.S. Patent No. 5,822,735 to DeLapa et al. and further in view of U.S. Patent No. 6,035,280 to Christensen?

However, Appellant notes that the Patent Office reopened prosecution in the application and that the independent claims, which the Board affirmed the prior rejection of, were amended such that the Final Office Action's statement that claims 30-37, 39-47, and 49 were withdrawn

from consideration is erroneous since the amended claims are not the same as those that the Board previously affirmed the Office's rejection.

### VIII. ARGUMENTS

By reopening prosecution only with respect to claims 38 and 48 and stating grounds of rejection for only these two claims in the Final Rejection of January 27, 2004, Appellant assumes that the Examiner adopted all of the remaining determinations of the Board. Of these remaining determinations, Appellant traverses the Board's affirmation of the rejection of claims 30-37, 39-47, and 49 for the following reasons.

In affirming the rejection of claims 30-37, 39-47, and 49 as being obvious over U.S. Patent No. 4,882,675 to Nichtberger et al. in view of U.S. Patent No. 5,822,735 to DeLapa et al., the Board of Patent Appeals and Interferences relied upon the portion of the specification at page 6 that stated "[t]he term coupons, as used herein, shall mean any mode of communication with a consumer or a potential consumer offering a specific discount to the consumer wherein the consumer needs to bring such proof back to a store for redemption" to limit the term coupon to "coupons...capable of being brought into a store" such that the electronic coupons that consumers can select in Nichtberger et al. were not considered to be coupons within the claims. Appellant submits that this is both an erroneous interpretation of the term coupon and an erroneous application of "coupon" to the actual claimed term -- "coupon information."

The statement on page 6 of the specification does not limit "coupons" to paper-type coupons. Indeed, the electronic coupons of both Nichtberger et al. and those of Appellant's

invention require the consumer to bring proof of ownership (card 220 of Nichtberger et al. or a frequent shopper card of Appellant) back to the store for redemption. Furthermore, Appellant's specification, on page 8, clearly contemplates electronic coupons wherein it states "a store can mail to a consumer a periodic summary of the information on a regular basis and may include other promotions or *coupons that have already been entered into the system* based on the market information collected for that consumer." (Emphasis added) This use of electronic coupons that are outside the selection control of consumers has been added to the independent claims and is also found in claims 32 and 42.

Furthermore, the actual claim language "coupon information" is clearly different from "coupon" as defined by the Board. It is different in that coupon information can clearly be in electronic form; this is what is stored in the database, whether it is from a scanned paper coupon or from one "already entered into the system" by the store "based on the market information collected for that consumer." In Nichtberger et al., the selection of electronic coupons by the consumer adds coupon information to their accounts. Indeed, if "coupon" within the claims meant "paper coupon," then the adjective "paper" in the claim term "paper coupons" would be superfluous.

Appellant's invention both leverages the existing paper coupon system and eliminates the possible fraudulent use of electronic coupons by consumers (e.g., a consumer applying for multiple accounts in order to be able to select and use the same electronic coupons more times than permitted) by taking the selection of electronic coupons away from the consumer. In this way, electronic coupons can be used by manufacturers and stores to reward shoppers, yet be less

prone to fraudulent schemes.

In view of the above-mentioned reasons, Appellant submits that claims 30-37, 39-47, and 49 are patentable over U.S. Patent No. 4,882,675 to Nichtberger et al. in view of U.S. Patent No. 5,822,735 to DeLapa et al.

With respect to claims 38 and 48, which were previously rejected as obvious over Nichtberger et al. in view of DeLapa et al. and further in view of Official Notice, the Board of Patent Appeals and Interferences held that “the only suggestion for modifying Nichtberger in the manner proposed by the examiner to meet the limitations of claims 38 and 48 stems from hindsight knowledge derived from the appellant’s own disclosure.” Although this holding specifically excluded consideration of Christensen (see fn. 9), it accepted the Official Notice that Internet review of coupons was known and yet still agreed that the claim limitations were “not suggested by the Office Notice of reviewing coupons through the Internet.”

The latest rejection from the Patent Office substitutes Christensen for the Official Notice of the prior rejection, with the stated motivation to combine being “because it provides convenience to the user by allowing the user to access coupons of interest quickly by performing a word search, and review, select, and retrieve coupon information directly from the operations center.” Appellant submits that Christensen is even less relevant than the prior Official Notice and that the Examiner has again impermissibly engaged in hindsight reconstruction based upon Appellant’s disclosure.

U.S. Patent No. 6,035,280 to Christensen teaches a virtual coupon distribution system wherein users browse coupons using software on a personal computer and select coupons to be



printed out for redemption via a coupon list. Although primarily disclosed as using a diskette for coupon distribution, Christensen further discloses that “diskette 310 may be substituted or augmented by downloading of data from an online service, Internet connection, E-mail, Website or the like.” Nowhere does it teach or suggest Internet review of unutilized coupon information in a consumer’s account. However, it does severely criticize the teachings of U.S. Patent No. 5,353,218 to DeLapa et al. which has an identical disclosure to the continuation application that led to issuance of the DeLapa et al. patent that forms a basis of the rejection (see Col. 2, ln. 36 to Col. 3, ln. 12 of Christensen)

Whereas Appellant’s claimed invention, as a whole, seeks to turn traditional paper coupons into virtual coupons and eliminate the fraud associated with consumer-selection of electronic coupons, Christensen teaches the opposite, having consumers select virtual coupons for printing onto a paper list that is scanned for redemption to eliminate the fraudulent use of traditional paper coupons. The only purpose for (Internet) access to coupons on the computer in Christensen is for either delivery (in place of diskettes) or to select coupons for printing on the list.

Additionally, Nichtberger et al. already teaches selection of coupons at home (col. 27, lines 46+) and seeks to eliminate paper coupons (i.e., teaches against printing out coupons for redemption) and therefore has no need to either seek or incorporate the teachings of Christensen. Because these references clearly teach against each other, it is also clear that the Examiner is again employing improper hindsight.

### IX. CONCLUSION

For the above reasons, Appellant respectfully submits that the Office Actions have failed to make out a *prima facie* case of obviousness with regard to claims 30-49 and asks that the obviousness rejections be reversed.

The present Supplemental Brief on Appeal is being filed in triplicate.

Appellant hereby petitions for any extension of time that may be required to maintain the pendency of this case, and any required fee for such extension is to be charged to Deposit Account No. 18-1579.

Respectfully submitted,



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## APPENDIX

1-29. (Cancelled)

30. An electronic coupon processing system for eliminating a presentation of printed coupons at a checkout register, comprising:

a plurality of consumer identification means wherein each consumer identification means is associated with a consumer;

a plurality of consumer accounts associated with said plurality of consumer identification means;

a database for storing information for each of said plurality of consumer accounts;

at least one means separate from a checkout register for each consumer to enter unutilized coupon information from printed coupons in the consumer's possession into said associated consumer account based on input of the consumer's consumer identification means so as to eliminate any need to present printed coupons at a checkout register;

at least one checkout register capable of collecting a consumer's purchase information, said register additionally being connected to said database;

means associated with said checkout register for reconciling the unutilized coupon information in each consumer's consumer account with the consumer's purchase information based solely on input of said consumer's consumer identification means; and

means for updating said consumer's consumer account to reflect utilization of coupons,

wherein said at least one means for each consumer to enter unutilized coupon information from printed coupons is the only means provided for consumers to add unutilized coupon information into their consumer account, and

the system includes means to add unutilized coupon information directly to consumer accounts.

31. The electronic coupon processing system of claim 30, wherein a consumer's frequent shopper card comprises said consumer identification means.

32. The electronic coupon processing system of claim 30, wherein additional unutilized coupon information is added to a consumer account by the system based on market information collected for a consumer associated with said consumer account.
33. The electronic coupon processing system of claim 30, wherein said database is connected to registers at a particular store or group of stores.
34. The electronic coupon processing system of claim 30, wherein said at least one means for each of said plurality of consumers to enter unutilized coupon information from printed coupons in their possession consists of a scanner.
35. The electronic coupon processing system of claim 34, wherein said scanner is located in a store and said store further includes means for viewing and a printer for providing a printout of unutilized coupon information in a consumer's consumer account based on input of said consumer's consumer identification means.
36. The electronic coupon processing system of claim 35, wherein said printout includes an aisle location for products associated with said coupon information in said consumer account.
37. The electronic coupon processing system of claim 30, wherein said means for reconciling automatically sends both purchase information and coupon information directly to a clearinghouse or a manufacturer for reimbursement.
38. The electronic coupon processing system of claim 30, further comprising means for providing Internet review of unutilized coupon information in a consumer's consumer account based on input of said consumer's consumer identification means.
39. The electronic coupon processing system of claim 38, further comprising means to provide a printout of unutilized coupon information in a consumer's consumer account.

40. An electronic coupon process for eliminating a presentation of printed coupons at a checkout register, comprising:
- a system associating a plurality of consumers with a plurality of consumer identification means;
  - the system associating a plurality of consumer accounts with said plurality of consumer identification means;
  - the system storing information for each of said plurality of consumer accounts in a database;
  - entering, at a location separate from a checkout register, unutilized coupon information from printed coupons in a consumer's possession into said associated consumer account based on input of said consumer's consumer identification means to eliminate any need to present printed coupons at a checkout register;
  - collecting said consumer's purchase information at a checkout register that is connected to said database;
  - reconciling the unutilized coupon information in said consumer's consumer account with the purchase information based solely on input of said consumer identification means of said specific consumer; and
  - updating a consumer account of said consumer to reflect utilization of coupons,
    - wherein consumers are limited to adding unutilized coupon information into their consumer account solely from printed coupons in their possession, and
    - the system can add unutilized coupon information directly to consumer accounts.
41. The electronic coupon process of claim 40, wherein a consumer's frequent shopper card is used as said consumer identification means.
42. The electronic coupon process of claim 40, further comprising adding additional unutilized coupon information to a consumer account based on market information collected for a consumer associated with said consumer account.

43. The electronic coupon process of claim 40, further comprising connecting said database to registers at a particular store or group of stores.
44. The electronic coupon process of claim 40, further comprising entering unutilized coupon information from printed coupons using a scanner.
45. The electronic coupon process of claim 44, further comprising locating said scanner in a store and said store further providing means for viewing and a printer for providing a printout of unutilized coupon information in a consumer's consumer account based on input of said consumer's consumer identification means.
46. The electronic coupon process of claim 45, further comprising printing out an aisle location for products associated with said coupon information in said consumer account.
47. The electronic coupon process of claim 40, wherein reconciling automatically sends both purchase information and coupon information directly to a clearinghouse or a manufacturer for reimbursement.
48. The electronic coupon process of claim 40, further comprising providing Internet review of unutilized coupon information in a consumer's consumer account based on input of said consumer's consumer identification means.
49. The electronic coupon process of claim 48, further comprising providing a printout of unutilized coupon information in a consumer's consumer account.